

ITZKOVITCH - 10/076,591
Client/Matter: 081627-0265363

REMARKS

Claims 1-20 are pending. By this Amendment, Figures 1, 8B and 10 are amended; the specification is amended; and claim 21 is canceled without prejudice or disclaimer.

Entry of the Amendment is proper under 37 C.F.R. §1.116 as the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not present any new issues that would require further consideration and/or search; (c) do not add any additional claims without canceling a corresponding number of claims; and (d) place the application in better form for appeal, by removing the rejection under 35 U.S.C. §112, first paragraph, should an appeal be necessary. Entry of this Amendment is respectfully requested.

Applicant appreciates the consideration of the Information Disclosure Statement filed November 18, 2003.

Applicant respectfully acknowledges the indication that claims 2-8 and 11-17 would be allowable if rewritten into independent form. However, in view of the foregoing amendments and the following remarks, Applicant respectfully submits that all of the claims are allowable.

Fig. 1 has been amended to replace reference number 140 with reference number 166, as amended on page 7, paragraph [00032]. Reference number 140 had been previously used to denote a bottom peripheral surface, on page 7, paragraph [00030]. Fig 8B has been amended by adding reference number 61, disclosed on page 5, line 5. Fig. 10 has been amended to change the dashed lines to solid lines, as the features are visible, not hidden. No new matter has been entered.

Claim 21 was rejected under 35 U.S.C. §112, first paragraph. Claim 21 has been canceled without prejudice thus rendering moot the rejection.

Claims 1, 9, 19 and 21 were rejected under 35 U.S.C. §103(a) over Vasudeva, U.S. Patent No. 5,887,715. The rejection is respectfully traversed.

Claim 1 recites a tool container including, *inter alia*, a case portion defining a storage space and a secondary cover portion being pivotably mounted to a cover portion.

Vasudeva does not disclose the tool container recited in claim 1. As shown, for example, in Fig. 8 of Vasudeva, the door 42 is pivotably mounted to the body 46 of the module 8, not to the lid 3. Figs. 6, 10, 12, 15, 16, 18 show similar embodiments. None of the embodiments of Vasudeva disclose or suggest a secondary cover portion pivotably mounted to a cover portion.

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In fact, Vasudeva does not disclose or suggest anything pivotably mounted to the lid 3. The rectangular opening 6 is provided in the main box portion 1, which includes the handle 2. See, for example, Figs. 1 and 14 of Vasudeva, which clearly show the module 8 attached to the main box portion 1, not the lid 3.

It is also respectfully submitted that the Examiner's determination that "Vasudeva discloses the cover portion (3, 46) having an elongated space therein and the secondary cover (42) for closing the elongated space . . . is capable of holding a level" (page 5, lines 5-7 of the Office Action) is incorrect, and irrelevant. As discussed above, the body 46 of the module 8 that defines the storage container 41 is in the main box portion 1, not the lid 3. Accordingly, the lid 3 of the Vasudeva does not have an elongated space, as incorrectly alleged by the Examiner. Even assuming the storage container 41 could be used to store a level, such a possibility would be irrelevant to the patentability of claim 1 because Vasudeva discloses that the storage container 41 is mounted to the main box portion 1, not the lid 3. As discussed above, the door 42 (which the Examiner incorrectly concludes corresponds to the claimed secondary cover portion) is pivotably mounted to the snap-in module 8, not to either the lid 3 or the main box portion 1.

Claims 9 and 19 are allowable by virtue of their dependence on claim 1 and additionally allowable for their recitation of additional patentable subject matter.

Claims 10, 18 and 20 were rejected under 35 U.S.C. §103(a) over Vasudeva in view of Mitchell, U.S. Patent No. 4,058,210. The rejection is respectfully traversed.

Neither Vasudeva nor Mitchell, alone or in combination, teach or suggest the combination tool container and level recited in claim 10. As noted above with respect to claim 1, Vasudeva does not disclose a secondary cover portion pivotably mounted to the cover portion, as recited in claim 10. The Office Action relies on Mitchell to teach a tool case having a small compartment for holding a small level. Specifically, Mitchell teaches L-shaped blocks secured to opposite ends of the case that are designed to provide a support for a level. This does not cure the deficiencies of Vasudeva noted above with respect to Vasudeva. Withdrawal of the rejection of claim 10 is respectfully requested.

Claims 18 and 20 are allowable by virtue of its dependence on claim 10 and additionally allowable for its recitation of additional patentable subject matter.

All objections and rejections have been addressed. It is respectfully submitted that the present application is now in condition for allowance, and a notice to that effect is earnestly solicited.

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Should there be any questions or concerns regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

PILLSBURY WINTHROP LLP



JACK S. BARUFKA

Reg. No. 37,087

Tel. No. (703) 905-2012

CAROLINE D. DENNISON

Reg. No. 34,494

Tel. No. (703) 905-2047

JOHN P. DARLING

Reg. No. 44482

Tel. No.: (703) 905-2045

Date: September 2, 2004

P.O. Box 10500
McLean, VA 22102
Tel. No.: (703) 905-2000
Fax No.: (703) 905-2500

Attachments:

Replacement Sheets (Figs. 1, 8B and 10)

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